



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/541,506

01/17/2006

Frank K. Botz

M 6700A PCT/US

4080

423 7590 09/25/2009

HENKEL CORPORATION

One Henkel Way

ROCKY HILL, CT 06067

EXAMINER

VASISTH, VISHAL V

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

09/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,506	Applicant(s) BOTZ ET AL.	
	Examiner VISHAL VASISTH	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30 and 62-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30 and 62-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's filed a response to a restriction/election requirement on 6/17/2009, and elected group II, claim 30 and added claims 62-77. Claims 1-29 and 31-61 were non-elected and cancelled in the response filed on 6/17/2009.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30, 62, 65-68, 70-71 and 74-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Murata et al., WIPO Publication No. WO/97/48783 (hereinafter referred to as Murata), but for purposes of citations examiner uses column and line numbers from Murata et al., US Patent No. 6,194,357 which is the national stage equivalent of the PCT application referred to above.

Murata discloses a lubricant composition comprising mineral oils such as animal oils (as recited in claims 30, 62, 68 and 71) (Col. 5/L. 5-13) and 0.2 to 5 wt% of a non-ionic surfactant such as polyoxyethylene alkyl ethers, polyoxyethylene alkylphenyl ethers, polyoxyethylene alkyl esters derived from polyethylene glycol and higher fatty acids, and polyoxyethylene sorbitan alkyl esters deriving from higher fatty acids, sorbitan, and polyethylene glycol (as recited in claims 30, 65-68 and 74-76) (Col. 5/L. 30-38 and Col. 6/L. 39-42).

It is the position of examiner that the limitations of claim 30 are inherently present within the teachings of Murata since Murata discloses both the mineral oil and surfactant components for lubricating composition as disclosed, thus inherently providing for a reduction in coefficient of friction when the liquid film lubricant is wetted as compared to the coefficient of friction of the lubricant when unwetted.

It is the position of examiner that the limitations of claims 68 and 70 are inherently present within the teachings of Murata since Murata discloses both the mineral oil and surfactant components for lubricating composition as disclosed, thus inherently providing for a resistance to damage, by contact with the composition of Murata such that a coefficient of friction, measured after such contact, does not exceed an initial coefficient of friction measured under the same conditions prior to contact by an amount that is more than 50%.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1797

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 64 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata.

Murata discloses all of the limitations discussed above including mineral oils such as animal oils. Murata does not, however, explicitly disclose the kinematic viscosity of the animal oils within the claimed range.

However, Murata discloses that the base oil has a kinematic viscosity between 5 to 100 cSt at 40°C (which encompasses and overlaps the range kinematic viscosity at 40°C of at least 2.5 cSt) (Col. 4/L. 59-61). The ranges of Murata therefore overlap and encompass the claimed ranges. See MPEP 2144.05(I): “In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).”

Claim Rejections - 35 USC § 103

7. Claims 63, 69, 72 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata in view of DiBiase et al., US Patent No. 4,800,031 (hereinafter referred to as DiBiase).

Murata discloses all of the limitations discussed above including mineral oils such as animal and plant oils and fats such as rapeseed oil and castor oil and synthetic oils that can be used alone or in combination (Col. 5/L. 5-20). Murata does not, however, explicitly disclose any of the oils being naphthenic oils.

Art Unit: 1797

DiBiase discloses a lubricant composition comprising natural oils such as castor oil that can be used in a mixture with naphthenic oils (Col. 3/L. 28-32 and Col. 4/L. 30-53) and non-ionic surfactants such as ethylene oxide/propylene oxide block copolymers (Col. 21/L. 15-19).

It is the position of examiner that the limitations of claim 77 are inherently present within the teachings of Murata in view of DiBiase since the combination of references both the base oil and surfactant components for lubricating composition as disclosed, thus inherently providing for a resistance to damage, by contact with the composition of Murata/DiBiase such that a coefficient of friction, measured after such contact, does not exceed an initial coefficient of friction measured under the same conditions prior to contact by an amount that is more than 50%.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the base oils of DiBiase in the composition of Murata as naphthenic base oils are very well known in the art and are a type of mineral oil and mineral oils are disclosed in Murata.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

Art Unit: 1797

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797

VVV